

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following remarks.

Claim Status

Claims 1-3 and 5-16 are pending and claims 9-11 have been withdrawn. Claim 1 is amended to remove alternative embodiments and to include the elements of claim 4. Claim 4 is cancelled, without prejudice. Withdrawn claim 9 is amended to conform to U.S. practice, as supported by the specification generally, and particularly by the Examples. Withdrawn claim 10 is amended in conformity with claims 1-8. In addition, withdrawn claim 11 is amended. The amendment to claim 11 is supported by the paragraph bridging pages 12-13 of the specification. The withdrawn claims are amended in view of the possibility of rejoinder, as noted by the Examiner at page 3 of the Office Action.

New claims 12-15 are supported by original claims 1, 3, 5 and 6, respectively. New claim 16 is supported by the specification, e.g., at page 10, lines 13-22.

No new matter is added.

The Restriction Requirement

The Examiner has made a restriction requirement in the above identified patent application. Applicants hereby affirm the election made by the undersigned, during a telephone interview, on July 30, 2009, electing restriction Group I, claims 1-8, with traverse.

The Information Disclosure Statement

The Examiner has advised, at page 4 of the Office Action, that, "[t]he listing of references in the specification is not a proper information disclosure statement." The Examiner further states that, "unless the references have been cited by the examiner on form PTO-892, they have not been considered."

Attached is Form SB08A citing the three references from pages 2 and 4 of the application and copies of these three references are provided herewith. The fee associated with this IDS is paid concurrently herewith.

Objection and Amendments to the Abstract

The Abstract is now amended to comprise a single paragraph, as required, and to remove the previous last sentence of the original Abstract, thus obviating this ground of objection.

For this reason, reconsideration and withdrawal of this ground of objection is respectfully requested.

Objections and Amendments to the Specification

The Examiner has objected to the lack of section headings, conforming to 37 CFR 1.77(b) in the specification. The specification is now amended to include both section headings and a Brief Description of the Drawings, thus obviating this ground of objection.

The Examiner has also objected that tradenames in the application are not in upper case form. This has now been corrected, thus obviating this ground of objection.

The specification is also amended to include a Brief Description of the Drawings. The description of Figure 1 is supported by the specification at page 1, lines 29-39. The description of Figure 2 is supported by the specification at page 2, lines 1-12.

For this reason, it is respectfully requested that all grounds of objection to the specification be reconsidered and withdrawn.

Objections to the Claims

The Examiner has objected to claims 2-8 for lacking "the" at the beginning of each respective claim. Claim 8 is objected to for reciting "further" and "the said" in the body of the text. The Examiner's attention to these points is appreciated. Claim 4 is cancelled, without prejudice, thus obviating the objection as to this claim. The remaining pending claims have been amended in conformity, thus obviating these grounds of objection.

For all of these reasons, reconsideration and withdrawal of these grounds of objection is respectfully requested.

Rejection Under 35 U.S.C. 112, Second Paragraph

The Examiner has rejected claims 1-8 for reciting alternative numerical ranges within a single claim.

The Examiner has also rejected claims 3, 4 and 8 for an alleged lack of antecedent basis for "the mean particle size," "the carbodiimide type," "the epoxy type," the bonding" and "in particular." The Examiner has also rejected claim 4 for reciting, "type" as allegedly introducing an indefinite element into the claim. The Examiner has also rejected claim 8 for reciting, "intended" and "the bonding" as allegedly introducing indefinite elements into the claim.

The Examiner's attention to each of these points is appreciated. Claim 4 is cancelled, without prejudice, thus obviating the rejection as to this claim. The remaining pending claims have been amended as required to conform to U.S. practice, thus obviating these grounds of rejection.

For all of these reasons, reconsideration and withdrawal of these grounds of rejection is respectfully requested.

Prior Art Rejections

The following prior art rejections have been made:

(1) claims 1, 2 and 6 had been rejected under 35 U.S.C. 102(b) as anticipated by US Patent Publication No. 2004/0097638 ("Centner");

(2) claims 3 and 4-5 had been rejected under 35 U.S.C. 103(a) as unpatentable over Centner in view of Peters et al. (US 6,258,888B1; "Peters"); and

(3) claims 7-8 had been rejected under 35 U.S.C. 103(a) as obvious in view of Centner taken with US 6,586,090 (Nakagawa).

Claim 1 has been amended to add the limitations of claim 4, thus rejections (2) and (3) are now moot.

Turning to rejection (2), it was noted that Centner doesn't teach the crosslinkers recited in claim 4. Peter's had been cited to teach the crosslinkers of claim 4. However, the combination of Peters with Centner is improper because (1)

Centner doesn't teach the use of a crosslinker in his composition, thus one of skill in the art would not turn to Peters in the first place; and (2) Centner relates to adhesive and Peters relates to ink, the two fields are non-analogous.

The Examiner has taken the position that Centner teaches pressure sensitive adhesives based on the polymers listed as (a) through (f) (¶¶1-7 of Centner). The Examiner states that the polymers are prepared by emulsion polymerization (¶68 of Centner), and further that Center teaches aqueous polymer dispersions with solid contents from 17-75% by weight (¶90 of Centner). The Examiner reasons that if the claims are given their broadest possible interpretation, and if one makes certain assumptions, that the ranges for polymers and crosslinkers disclosed by Centner anticipates the invention as claimed.

Applicants respectfully disagree.

In order to anticipate a claim, the reference must teach every element of the claim (MPEP, Section 2131). In addition, "the prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP, Section 2121.03 (VI), citing to, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original).

Centner discloses a pressure sensitive adhesive (PSA) used to join substrates, of which at least one is made of plasticized PVC. The PSA is synthesized from, *inter alia*, 0 to 40% by weight of monomer (f), the monomer being other than monomers (a) to (e). According to ¶65 of Centner, monomers (f) do not include crosslinking monomers, "e.g., those having 2 or more than 2 ethylenically unsaturated groups." Given ¶65 of Centner, the additional use of crosslinkers, such as external crosslinkers added to the polymer for the purpose of crosslinking, is not necessary in the context of the Centner invention.

Applicants submit that a prior art reference must be considered not only for what it teaches, but also for "portions that would lead away from the claimed invention." It is respectfully submitted that the artisan understands that the PSA of Centner does not teach or suggest a crosslinking agent.

Thus, one of skill in the art would not turn to Peters for a crosslinker.

Peters teaches aqueous polymer emulsions intended for water-borne printing inks and overprint lacquer formulations. For this reason alone, it is respectfully submitted that Peters represents a nonanalogous reference. There is simply no imaginable reason or motivation of record for explaining why the ordinary artisan would have looked to a reference concerning

water based printing inks to solve any problems in providing an adhesive film for protecting car parts. As noted by MPEP 2141.01(a),

a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention.

In the present case, it is submitted that, despite the fact that Centner and Peters both describe polymers, there is no other useful factual commonality between the respective technologies, to such a degree that the Peters reference "would have commended itself" to the inventor's attention to remedy any deficiency in Centner in providing an adhesive film for protecting car parts.

The Examiner is respectfully requested to take administrative notice of the most basic difference between the technologies. The Centner adhesive film is designed to adhere to and provide an adhesive layer between two or more existing surfaces or materials, one of which is preferably plasticized PVC. On the other hand, it is submitted that Peters water based inks and lacquers are designed to coat or overcoat a substrate, and require specific spreading, drying and pigment holding or dispersing properties that are necessarily different from and not relevant to adhesives such as those taught by Centner (or by the instant patent application).

For this reason, the inks and lacquers of Peters are simply too different from Centners adhesive coatings in both composition and application, for one to reliably provide guidance to the artisan in the other technology in predictably solving problems within the respective technical areas.

Even if the Examiner maintains the above rejection, it is submitted that pending claims are not obvious over the alleged combination. The Peters emulsions comprise a hydrophobic polymer part, and an oligomer part, which is a low molecular weight polymer bearing acid groups. According to Peters, at columns 10-11, the monomer system for the oligomer comprises not more than 30% by weight of one or more of 2-ethylhexyl acrylate, ethyl acrylate, ethyl methacrylate, n-butyl acrylate, and n-butyl methacrylate.

As noted above, Centner teaches not using a crosslinking agent. In addition, as noted above, Centner teaches a PSA employed to join substrates, wherein at least one is made of plasticized PVC. Since Centner would not have taught or suggested employing a cross-linking agent, the ordinary artisan would not have had any suggestion or guidance to employ the optional crosslinking agent mentioned by Peters (Col. 14, lines 7-15).

Further, the polymer emulsion of Peters is intended for water based inks and overprint lacquer formulations. As noted

above, this is a completely different end use from the one intended by Centner. It is submitted that the artisan would, in fact, have been deterred from adding components that would materially affect the properties of the Centner adhesive.

Turning to Nakagawa, Nakagawa teaches an adhesive tape comprising a substrate and an adhesive layer formed on at least one side of the substrate, wherein the substrate comprises components that are substantially free of halogen elements, to avoid the formation of toxic fumes upon incineration. However, it is submitted that Nakagawa fails to teach or suggest the crosslinking of claim 1, as well as the requirements of claims 7-8, wherein "each layer of the support layer comprises..." the enumerated polymers. Instead, Nakagawa teaches a support formed of components A, B and C, each of which has a different composition (e.g., see Abstract). Thus, Nakagawa fails to remedy the clear deficiencies of Centner and Peters, as discussed above.

For all of these reasons, it is submitted that the claims are patentable over the references taken alone or in combination.

Conclusion

In view of the foregoing, it is believed that this Application is in condition for allowance and such action is respectfully requested. Should any fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: Donald C. Lucas
Donald C. Lucas, Reg. # 31,275
(Attorney for Applicant)
475 Park Avenue South
New York, New York 10016
Tel. # (212) 661-8000

DCL/LM/mr/ns